REMARKS

In section 3 of the Office Action, the Examiner rejected claims 1-68 under 35 U.S.C. §103(a) as being unpatentable over the Morton patent.

The Morton patent discloses a method of introducing potential customers to an information service. As shown in Figure 2, a potential customer potential customer 220 uses a telephone 240 to communicate with a current customer 280 by way of an information service 260. The information service 260 may provide a wide variety of services such as e-mail, fax, voice mail, answering services, call waiting, conference calling, and processing of requests for Web pages, newsgroup postings, financial information, and audio and multimedia files. The current customer 280 also communicates with the information service 260.

When the potential customer 220 initiates a communication with the current customer 280 as shown by step 310 of Figure 3, the information service 260 at step 320 receives the communication request, and the information service 260 identifies the potential customer 220 at step 330. At step 340, the potential customer 220 is placed on hold while the information service 260 contacts the current customer 280.

At step 350, the potential customer 220 interacts with the information service 260 during the hold time by allowing the potential customer 220 to browse the Internet, retrieve financial data, select music to be played, or request other information provided by the information service 260. The information service 260 can also provide the potential customer 220 with a features demo. At step 360, the information service 260 tracks its interaction with the potential customer 220.

At step 370, the information service 270 contacts the current customer 280 regarding the communication while the potential customer 220 interacts with the information service 260. The current customer 280 then has the opportunity to determine how the communication will be handled. For example, the information service 260 can take a message, place the potential customer 220 on hold for a few minutes, or inform the potential customer 220 that the current customer 280 will return the communication at a later time.

At step 380, the information service 260 reports back to the potential customer 220 and handles the communication as instructed.

Figure 4 of the Morton patent shows how the information service 260 processes a communication initiated by the current customer 280. At step 410, the current customer 280 initiates the communication. At step 420, the information service 260 identifies the potential customer 220. At steps 430, 440, and 450, the information service 260 notifies the current customer 280 of the communication. At step 460, the information service 260 allows the potential customer 220 to interact with the information service 260 as before. At step 470, the information service 260 tracks the interaction with the potential customer 220.

Also, a subsequent interaction between the potential customer 220 and the information service 260 can be initiated by the information service 260. Thus, after an initial contact, the information service 260 could automatically initiate a re-contact with the potential customer 220 to remind the potential customer 220 of the earlier interaction. This re-contact can be initiated based on previous tracking information.

Independent claim 1 is directed to a method in which a note is posted on a first computer at a first party content provider, in which a second party content recipient uses a second computer to electronically engage

in an activity related to the note, and in which payment is provided to a third party based upon the activity.

The Morton patent does not disclose or suggest a note that is posted on a computer of a first party content provider. Indeed, the Morton patent at most suggests downloading certain information to a potential customer while the potential customer (content recipient) interacts with an information service (content provider). However, there is no suggestion that such information is in the form of a note.

Because the Morton patent does not disclose or suggest a note, the Morton patent cannot disclose or suggest the electronic engagement in an activity related to the note by a second party content recipient as required by independent claim 1.

For this reason, independent claim 1 is patentable over the Morton patent.

Moreover, the Morton patent does not disclose or suggest providing payment to a third party based upon an activity involving a note. The Examiner asserts that the Morton patent suggests providing such payment because "The invention has been described [in the Morton patent] primarily in the context of operating a viral marketing

system in connection with an information service having a voice interface."

Applicants assume that the Examiner believes that a viral marketing system is one that derives revenues. However, even if this belief is warranted, deriving revenues based on the services offered by the information service 260 does not mean that revenues are provided to a third party based upon an activity engaged in by a content recipient with respect to a note posted by a content provider. Indeed, the Morton patent does not suggest providing payment to a third party based upon any activity, much less based upon an activity engaged in by a content recipient with respect to a note posted by a content provider.

Because the Morton patent does not disclose or suggest providing payment to a third party based upon an activity engaged in by a content recipient with respect to a note posted by a content provider, the Morton patent cannot disclose or suggest the invention of independent claim 1.

For this reason also, independent claim 1 is patentable over the Morton patent.

Examiner's Response - The Examiner generally argues that the invention of independent claim 1 is

either somehow suggested by the Morton patent or that the invention of independent claim 1 is within the knowledge generally available to one of ordinary skill in the art.

However, these assertions are mere conclusions and, as such, do not support the Examiner's rejection of independent claim 1.

Moreover, the Examiner does not specifically deal with applicant's argument that the Morton patent fails to suggest the posting a note on a computer at a content provider. The Examiner fails to point to any disclosure in the Morton patent that describes or shows a note that is posted by the information service (assuming that the information service is the first party content provider.

Furthermore, the Examiner fails to carry his burden of making a *prima facie* case that the invention of independent claim 1 is somehow within the knowledge generally available to one of ordinary skill in the art. Certainly, the Morton does not disclose or suggest a method in which a note is posted on a first computer at a first party content provider, in which a second party content recipient electronically engages in an activity related to the note, and in which payment is provided to a third party based upon that activity. The viral

marketing system discussion in the Morton patent is much too nebulous to suggest such a method, and the Examiner's argument regarding the knowledge available to one of ordinary skill in the art is mere conclusion and is not supported by either evidence or logical reasoning.

Accordingly, the Examiner has not demonstrated that independent claim 1 is unpatentable.

Independent claim 29 is directed to a method in which a note is posted at a first party content provider, in which a note program code at a second party content recipient is executed so as to download the note without resort to a cut or copy operation and without downloading a web page of the content provider, wherein the content recipient is a second party, and in which payment is provided to a third party based upon the note.

As discussed above, the Morton patent does not disclose or suggest a note that is posted at a first party content provider. Indeed, the Morton patent at most suggests downloading certain information to a potential customer 220 (content recipient) while the potential customer 220 interacts with an information service 260 (content provider). However, there is no suggestion that such information is in the form of a note.

Because the Morton patent does not disclose or suggest a note, the Morton patent cannot disclose or suggest the execution of program code related to the note at a second party content recipient as required by independent claim 29.

For this reason, independent claim 29 is patentable over the Morton patent.

Moreover, the Morton patent does not disclose or suggest providing payment to a third party based upon a note. The Examiner asserts that the Morton patent suggests providing such payment because "The invention has been described [in the Morton patent] primarily in the context of operating a viral marketing system in connection with an information service having a voice interface."

As also discussed above, Applicants assume that the Examiner believes that a viral marketing system is one that derives revenues. However, even if this belief is warranted, deriving revenues based on the services offered by the information service 260 does not mean that revenues are provided to a third party based upon a note posted by a second party content provider. Indeed, the Morton patent does not suggest providing payment to a

third party based upon a note which relates to program code executed at a second party content recipient.

Because the Morton patent does not disclose or suggest providing payment to a third party based upon a note which relates to program code executed at a second party content recipient, the Morton patent cannot disclose or suggest the invention of independent claim 29.

For this reason also, independent claim 29 is patentable over the Morton patent.

Furthermore, the Morton patent does not disclose or suggest executing a note program code at a second party content recipient so as to download the note without resort to a cut or copy operation and without downloading a web page of the content provider.

For this additional reason, independent claim 29 is patentable over the Morton patent.

Examiner's Response - As discussed above, the Examiner argues in a very general fashion that the invention of independent claim 29 is either suggested by the Morton patent or that the invention of independent claim 29 is within the knowledge generally available to one of ordinary skill in the art.

However, the Examiner does not specifically deal with applicant's argument that the Morton patent fails to suggest the posting a note on a computer at a content provider. The Examiner fails to point to any disclosure in the Morton patent that describes or shows a note that is posted by the information service (assuming that the information service is the first party content provider.

Moreover, the Examiner fails to carry his burden of making a *prima facie* case that the invention of independent claim 29 is within the knowledge generally available to one of ordinary skill in the art. Certainly, the Morton does not disclose or suggest a method in which a note is posted at a first party content provider, in which a note program is executed at a second party content recipient so as to download the note without resort to a cut or copy operation and without downloading a web page of the content provider, and in which payment is provided to a third party based upon the note. The viral marketing system discussion in the Morton patent is much too nebulous to suggest such a method, and the Examiner's argument regarding the knowledge available to one of ordinary skill in the art

is mere conclusion and is not supported by either evidence or logical reasoning.

Accordingly, the Examiner has not demonstrated that independent claim 29 is unpatentable.

Independent claim 41 is directed to an arrangement of sites comprising first, second, and third sites. The first site is a content provider site coupled to a network, the first site executes first program code for the posting of a note thereat, the first site is operated by a content provider, and the content provider is a first party. The second site is a content recipient site coupled to the network, the second site executes second program code, the second program code is compliant with the note posted at the first site, the second site is operated by a content recipient, and the content recipient is a second party. The third site is operated by a third party, and the third site receives payment based upon the note posted at the first site.

As discussed above in connection with independent claim 1 and 29, the Morton patent does not disclose or suggest posting a note, and does not disclose or suggest receiving payment at a third site based upon a note that is posted at a first site and that is compliant with program code executed at a second site.

For both of these reasons, independent claim 41 is patentable over the Morton patent.

Examiner's Response - The Examiner makes the same response with respect to independent claim 41 as the did with respect to independent claims 1 and 29. As applicants have demonstrated above, this response does not show that the independent claims herein are unpatentable.

In section 4 of the Office Action, the Examiner rejected claims 1-68 under 35 U.S.C. §103(a) as being unpatentable over the Morton patent. Applicants assume that the Examiner meant to reject claims 69-80 in section 4 of the office action.

Dependent claims 69, 71, and 73 recite that the note has an attachment characteristic such that the note is attachable to a window. The Morton patent does not disclose or suggest a note that has this attachment characteristic. At most, the Morton patent suggests having content embedded in a web page rather than content attached to the web page. Therefore, dependent claims 69, 71, and 73 are patentable over the Morton patent.

The Examiner takes official notice that both the concepts and the advantages of the limitations of dependent claims 69, 71, and 73 were well known and

expected in the art. Taking official notice is a much abused practice of the Patent and Trademark Office because it attempts to absolve examiners of finding art for claim limitations. Applicants challenge the Examiner to find the art that the Examiner says exists.

Moreover, the Examiner goes on to opine that, assuming the existence of prior art that discloses the notes of the corresponding independent claims 1, 29, and 41 being attachable to a window, it would have been obvious to make the notes not disclosed in the Morton patent attachable to windows because such a feature would provide a viral marketing system. The Examiner is getting a lot of mileage out of that rather nebulous disclosure.

However, the viral marketing system as described in the Morton patent does not suggest the limitations of dependent claims 69, 71, and 73. It does not even hint at attachable notes. Moreover, the viral marketing system as described in the Morton patent does not suggest the desirability of using attachable notes for the notes recited in independent claims 1, 29, and 41. At the very least, the Morton patent does not even hint that attachable notes would add to the viralness of a marketing system.

Similarly, there is nothing in the "knowledge available to one of ordinary skill in the art" to suggest the limitations of dependent claims 69, 71, and 73. While the assignee of the present application has patents that disclose attachable software notes, the desirability of using such notes for the notes recited in independent claims 1, 29, and 41 is not known or suggested.

For all of these reasons, dependent claims 69, 71, and 73 are patentable over the Morton patent.

Dependent claims 70, 72, and 74 recite that the notes of independent claims 1, 29, and 41 have an attachment characteristic such that the notes are attachable to a window by a drag and drop operation. The Morton patent does not disclose or suggest a note that can be attached through a drag and drop operation. At most, the Morton patent suggests having content embedded in a web page rather than content attached to the web page. Therefore, dependent claims 70, 72, and 74 are patentable over the Morton patent.

The Examiner takes official notice that both the concepts and the advantages of the limitations of dependent claims 70, 72, and 74 were well known and expected in the art. Applicants challenge the Examiner to find the art that the Examiner says exists.

Moreover, the Examiner goes on to opine that, assuming the existence of prior art that discloses the notes of the corresponding independent claims 1, 29, and 41 being attachable to a window, it would have been obvious to make the notes not disclosed in the Morton patent attachable to windows because such a feature would provide a viral marketing system. However, the viral marketing system as described in the Morton patent does not suggest the limitations of dependent claims 70, 72, and 74. It does not even hint that notes can be dragged and dropped so as to attach them. Moreover, the viral marketing system as described in the Morton patent does not suggest the desirability of using a drag and drop operation to attach the notes recited in independent claims 1, 29, and 41. At the very least, the Morton patent does not even hint that such notes would add to the viralness of a marketing system.

Similarly, there is nothing in the "knowledge available to one of ordinary skill in the art" to suggest the limitations of dependent claims 70, 72, and 74. While the assignee of the present application has patents that disclose notes that can be attached through a drag and drop operation, the desirability of using such notes

for the notes recited in independent claims 1, 29, and 41 is not known or suggested.

For all of these reasons, dependent claims 70, 72, and 74 are patentable over the Morton patent.

Dependent claims 75, 76, and 77 recite that the notes of independent claims 1, 29, and 41 are posted on a web page of the content provider and can be downloaded to the content recipient separately from the web page. The Morton patent does not disclose or suggest a note that can be downloaded separately from the web page. The Morton patent is completely silent on the subject or anything like the subject. Therefore, dependent claims 75, 76, and 77 are patentable over the Morton patent.

The Examiner takes official notice that both the concepts and the advantages of the limitations of dependent claims 75, 76, and 77 were well known and expected in the art. Applicants challenge the Examiner to find the art that the Examiner says exists.

Moreover, the Examiner goes on to opine that, assuming the existence of prior art that discloses the notes of the corresponding independent claims 1, 29, and 41 being downloaded separated from the web page to which they are attached, it would have been obvious to adopt the use of these in the system disclosed in the Morton

patent because such a feature would provide a viral marketing system. However, the viral marketing system as described in the Morton patent does not suggest the limitations of dependent claims 75, 76, and 77. It does not even hint that notes can be downloaded separately from a web page. Moreover, the viral marketing system as described in the Morton patent does not suggest the desirability of downloading the notes recited in independent claims 1, 29, and 41 separately from a web page. At the very least, the Morton patent does not even hint that such notes would add to the viralness of a marketing system.

Similarly, there is nothing in the "knowledge available to one of ordinary skill in the art" to suggest the limitations of dependent claims 75, 76, and 77.

For all of these reasons, dependent claims 75, 76, and 77 are patentable over the Morton patent.

Dependent claims 78, 79, and 80 recite that the note is posted on a web page of the content provider and has a characteristic such that the note can be automatically downloaded to the content recipient separately from the web page. The Morton patent does not disclose or suggest a note that can be automatically downloaded separately from the web page. The Morton

patent is completely silent on the subject or anything like the subject. Therefore, dependent claims 75, 76, and 77 are patentable over the Morton patent.

The Examiner takes official notice that both the concepts and the advantages of the limitations of dependent claims 75, 76, and 77 were well known and expected in the art. Applicants challenge the Examiner to find the art that the Examiner says exists.

Moreover, the Examiner goes on to opine that, assuming the existence of prior art that discloses the notes of the corresponding independent claims 1, 29, and 41 being automatically downloaded separated from the web page to which they are attached, it would have been obvious to adopt the use of these in the system disclosed in the Morton patent because such a feature would provide a viral marketing system. However, the viral marketing system as described in the Morton patent does not suggest the limitations of dependent claims 75, 76, and 77. It does not even hint that notes can be downloaded separately from a web page. Moreover, the viral marketing system as described in the Morton patent does not suggest the desirability of automatically downloading the notes recited in independent claims 1, 29, and 41 separately from a web page. At the very least, the

Morton patent does not even hint that such notes would add to the viralness of a marketing system.

Similarly, there is nothing in the "knowledge available to one of ordinary skill in the art" to suggest the limitations of dependent claims 75, 76, and 77.

For all of these reasons, dependent claims 75, 76, and 77 are patentable over the Morton patent.

Because the independent claims of the present application are patentable over the Morton patent, the dependent claims, including dependent claim 2-28, 30-40, and 42-68, are likewise patentable over the Morton patent.

The Examiner contends in paragraph 5 of the office action that the Official Notice taken by the Examiner in the first office action with respect claims 2-28, 30-40, and 42-68 was not traversed by the applicants and is therefore admitted. Applicants have admitted nothing of the kind. Indeed, because of the patentability of the independent claims of this application both before and after the first amendment and this amendment, applicants did deem it economical to traverse a rejection of the dependent claims.

Applicants do not admit the Examiner's official notice and indeed have argued that the Examiner's

official notice is merely an attempt to avoid finding prior art.

CONCLUSION

In view of the above, the claims of the present application patentably distinguish over the art applied by the Examiner. Accordingly, allowance of these claims and issuance of the present application are respectfully requested.

Respectfully submitted,

SCHIFF HARDING LLP
6600 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
(312) 258-5500

By: _____
Trevor B. Joike
Registration No.: 25,542
Attorney for Applicants

May 27, 2004